APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,936	01/05/2000	HARRY E. EMERSON	17617-46	9952

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EXAMINER
MYHRE, JAMES W

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary

	Application No. 09/477,936	Applicant(s) Emerson et al
	Examiner James W. Myhre	Art Unit 3622

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____3____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 12, 2003* _____ .

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-12* _____ is/are pending in the application.

   4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-12* _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some* c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

   a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1.   The response filed on February 12, 2003 under 37 CFR 1.111 has been considered but is

ineffective to overcome the <u>Chen et al</u> (5,917,830), <u>Capek et al</u> (6,094,677), and <u>Wachob</u>

(5,155,591) references.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> .manner in which the invention was made.

3.   Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Chen et al</u>

(5,917,830) in view of <u>Capek et al</u> (6,094,677) and <u>Wachob</u> (5,155,591).

        Claims 1 and 7: <u>Chen</u> discloses a system and method for substituting advertisements

during a broadcast, comprising:

        a. Generating, digitizing, and storing a plurality of replacement commercials (e.g.

advertisements) for insertion into the broadcast (col 4, lines 39-41 and col 13, lines 15-20);

        b. Marking the broadcast with the start and end times (e.g. duration) of the

commercial (col 2, lines 18-21; col 6, line 66 - col 7, line 10; and col 13, lines 15-20);

        c. Receive the broadcast (col 13, lines 57-62);

d. Detect and read the insertion marker on the broadcast (col 6, lines 1-10 and col 12, lines 36-37);

e. Select and substitute (insert) a replacement commercial into the broadcast at a point corresponding to the insertion marker (col 8, lines 1-5 and col 14, lines 3-12); and

f. Repeat the detection and insertion of replacement commercials throughout the broadcast (col 13, line 61 - col 14, line 7).

While <u>Chen</u> uses a network television broadcast as an exemplary use of the invention, it is also disclosed that the invention can be applied "for splicing a secondary packetized data stream, such as a commercial, with a primary packetized data stream" (col 4, lines 7-9) and that the secondary packetized data streams (commercials) being inserted (spliced) "may include digital audio tapes" or "compact audio discs (CDS)" (col 4, lines 39-43) and that "audio only or data only messages may be inserted into the main packetized data stream" (col 4, lines 57-59). The Applicant's invention is directed to inserting a replacement commercial into a radio broadcast being received via the Internet. The Examiner notes that both radio and television broadcasts may be received via the Internet, and that both are "packetized data streams". Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the packetized data stream into which <u>Chen</u> is inserting commercials could contain either audio/video data (i.e. television) or only audio data (i.e. radio). One would have been motivated to use <u>Chen</u>'s system and method to insert commercials into a radio broadcast in view of his disclosure of inserting audio only data and storing digital audio tapes.

Chen discloses replacing main stream commercials with the selected commercials (col 14, lines 7-12) and also discloses marking and detecting the start and end times of the insertion points (T_in and T_out; col 13, lines 15-20). Additionally, Chen discloses that "the system should avoid any discontinuity which results in a non-compliant data stream. The data stream should also preclude problems such as syntax violations, decoding errors, buffer overflow or underflow, timing recovery problems due to discontinuous time stamps, audio/video synchronization problems, and video display artifacts" (col 1, line 65- col 2, line 3). While it is not explicitly disclosed that a comparison is made to determine whether the duration of the replacement commercial corresponds to the duration of the main stream commercial being replaced (based on the start and end times), it is implied that such a comparison is being made in order to "avoid discontinuity" and "buffer overflow or underflow" and to ensure that the beginning of the replacement commercial(s) is at T_in and the end of the replacement commercial(s) is at T_out (col 14, lines 3-7). Capek discloses a similar system and method for inserting commercials into data streams containing content information which also determines whether the duration of the insertion point is sufficiently long to allow insertion of a commercial (col 4, lines 43-51; col 5, lines 23-28; and col 9, lines 57-61). This implies that the duration of each stored replacement commercial is known and used in the determination (comparison). Wachob also discloses a similar system and method for providing targeted advertisements to users with a cable television broadcast as an exemplary use of the invention. Wachob further explicitly discloses that the targeted advertisement would replace the original advertisement in the broadcast and be selected

based on the determination of "the length of the impending commercial message break" (col 7,

lines 34-37) based on received tag information which "defines if and when a commercial is about

to occur, how long it will last" (col 7, lines 18-19). Therefore, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to compare the durations of the

main stream commercial and the replacement commercial when selecting the replacement

commercial in the Chen invention. One would have been motivated to compare these durations in

order to decrease the likelihood of "blank time" during the reception of the broadcast if the

replacement commercial was shorter than the main stream commercial or "overwriting" of the

main stream broadcast (content) if the replacement commercial was longer than the main stream

commercial.

Claim 2: Chen, Capek, and Wachob disclose a method and system for substituting

advertisements during a broadcast as in Claim 1 above. Chen also discloses that the marking of

the start and end times of the insertion point is performed by the broadcast station (col 6, line 66 -

col 7, line 10 and col 13, lines 15-20).

Claim 3: Chen, Capek, and Wachob disclose a method and system for substituting

advertisements during a broadcast as in Claim 2 above. Both Chen and Capek also disclose

digitizing the audio stream into sequential packets to allow for presenting a series of packets in

the proper order as one complete commercial (Chen, Fig. 6a, items A1-A11 and col 14, lines 56-

65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

Claims 4-6, 8, and 9: Chen, Capek, and Wachob disclose a method and system for

substituting advertisements during a broadcast as in Claims 1, 2, 3, and 7 above. While Chen

does not explicitly disclose using consumer demographics to select (target) the replacement

commercial, Capek discloses that the information "may be customized to either the user or the

material requested, or both" (col 4, lines 43-51 and col 8, lines 7-58) and that "the insertion

manager 20 them selects a customized insertion based upon the client profile for the requesting

client" (col 12, lines 32-39), or type of information requested (col 12, lines 34-39). Wachob also

discloses selecting the targeted advertisement "based on the viewer's demographic

characteristics" (col 2, lines 62-65). Therefore, it would have been obvious to one having ordinary

skill in the art at the time the invention was made to base the selection of the commercials in Chen

upon the consumer's demographic information. One would have been motivated to use this type

of selection in Chen in order to present commercials which are more pertinent to the consumer

("to increase the users interest and to make the information more engaging", Capek, col 7, lines 8-

10), thus increasing the acceptance and interaction with the commercial by the consumer.

Claim 10: Chen, Capek, and Wachob disclose a method for substituting advertisements

during a broadcast which performs steps (a) - (m) of Claim 1 and further performs the steps in

which consumer demographic data and advertisement type information are stored and used to

select the replacement advertisement as in Claims 4 and 5 above.

Claim 11: Chen, Capek, and Wachob disclose a method for substituting advertisements

during a broadcast as in Claim 10 above. Chen further discloses that the marking of the start and

end times of the insertion point is performed by the broadcast station as in Claim 2 above (col 6,

line 66 - col 7, line 10 and col 13, lines 15-20).

Claim 12: Chen, Capek, and Wachob disclose a method for substituting advertisement

during a broadcast as in Claim 11 above. Both Chen and Capek also disclose digitizing the audio

stream into sequential packets to allow for presenting a series of packets in the proper order as

one complete commercial as in Claim 3 above (Chen, Fig 6a, items A1-A11 and col 14, lines 56-

65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

Response to Arguments

4.   Applicant's arguments filed February 12, 2003 have been fully considered but they are not

persuasive.

        A. The Applicant argues in reference to Claims 1 and 7 that Chen does not disclose that

the packetized data stream is being delivered to an Internet hosting service, nor that it is a bi-

directional communication system (page 3). The Examiner notes that, as discussed in the

rejection above, both television and radio transmissions can be received over the Internet.

Furthermore, many cable television systems also offer Internet connections via the customer's

cable television lines, thus becoming "Internet hosting services". Since Chen shows that the

Video Information Providers (VIP)(i.e. cable television system) includes an internet gateway as

the Applicant pointed out, it is obvious that the Video Information User (VIU)(i.e. customer)

could connect to and receive information, such as radio or television broadcasts, from the Internet

through <u>Chen</u>'s cable television system. This is made even more explicit by <u>Chen</u>'s disclosure that

the packetized data stream is ultimately delivered through the cable television network and

displayed to the VIU "via televisions 170, 172 and/or personal computer 174" (col 5, lines 15-17).

The Examiner also notes that, although argued by the Applicant, there does not seem to be any bi-

directional communication in the claimed invention other than the presumption that the customer

has requested to view or listen to the desired program either by tuning to the proper channel or by

connecting to the proper site online, which is also presumed to be the case in the cited references.

B. The Applicant argues in reference to Claims 1 and 10 that neither <u>Chen</u>, <u>Capek</u>, nor

<u>Wachob</u> disclose comparing the durations of the replacement commercial with the duration of the

main commercial being replaced (page 4). The Examiner notes that this has been discussed in the

rejection above. <u>Chen</u> discloses replacing the packets in the main stream with packets from the

secondary stream based on the start and end times (T_in and T_out) received from the main

stream, and further discloses that in a series of replacement commercials "the beginning of the first

commercial will correspond to T-in, and the end of the last commercial will end at T_out" (col 14,

lines 3-7). This implies that the duration of the replacement commercial is being compared to the

duration of time between T_in and T_out. Without such a comparison, <u>Chen</u> could not make the

cited statement. Additionally, both <u>Capek</u> and <u>Wachob</u> also disclose determining the duration of

the commercial opportunities. <u>Wachob</u>, in particular, explicitly discloses that the "tag information

defines if and when a commercial is about to occur, how long it will last" and "the length of the

impending commercial message break is determined from the tag information transmitted by the headend" (col 7, lines 18-20 and 34-36).

      C. The Applicant finally argues that "a proposed combination of references must be read as a whole" and that it is improper to "pick and choose among individual parts of assorted prior art references"..."to recreate a facsimile of the claimed invention" (pages 10 & 11). The Examiner agrees that the whole of each reference must be considered, but disagrees that all the individual parts of each reference must be compatibly combinable. Manytimes, even within a single reference, numerous alternate embodiments are disclosed which contain individual parts that are impossible or inane to combine with another embodiment's parts. For example, a bill paying system could contain one embodiment where the payee submits the payment via postal mail, another embodiment where the payer submits the payment via the Internet, and another embodiment where the payer submits the payment through automatic electronic funds transfer from his bank to the payee's bank. This clearly shows that there are three alternative ways to submit the payment. However, it would not make any sense whatsoever for the payer to submit a payment using all three of the disclosed methods...one payment is sufficient. In the present application, the Examiner has used three references which present various ways to replace and/or insert desired commercials into a packetized data stream, either with or without demographic targeting. It would have been obvious to one having ordinary skill in the art at the time the invention was made to consider each of these references (and others) and to choose the preferred features of each, depending on the desires and goals of the system designer.

D. The Applicant argues in reference to Claim 3 that <u>Chen</u> and <u>Wachob</u> do not disclose

distributing "programming that is customized and distributed in that form to a given user" (page

12). The Examiner notes that <u>Wachob</u> explicitly discloses selecting the commercial based on the

customer's demographic and that the "information can be transmitted on an individual basis where

it is addressed to a particular converter" (i.e. customer)(col 10, lines 23-24).

E. The Applicant argues in reference to Claims 4-6, 8 and 9 that <u>Chen</u> cannot use

demographic information to select the replacement commercial because he does not disclose bi-

directional connectivity such as found on the Internet. The Examiner notes that this was

discussed in the arguments above. <u>Chen</u> discloses that the information may be displayed to the

customer via his television set or personal computer. <u>Wachob</u> discloses that "Return paths for

providing two-way communication between cable television headends and subscriber converters

are well known in the art" (col 10, lines 40-42). Therefore, <u>Chen</u> not only discloses a bi-

directional personal computer at the customer location, but also discloses a cable television

network which is known to be able to provide two-way (bi-directional) communications. This,

taken together with the disclosure of targeting commercials over cable television in <u>Wachob</u> and

over the Internet in <u>Capek</u>, renders it obvious to provide targeted commercials to the customer

via <u>Chen's</u> bi-directional network.

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The

examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.
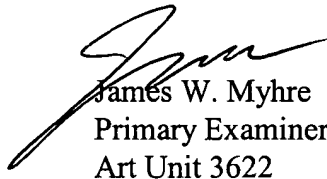
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal

or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be

submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
March 20, 2003

James W. Myhre
Primary Examiner
Art Unit 3622